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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,496	07/27/2006	Akio Taniguchi	5404/166	8335
757 7590 03/20/2009 BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610				
EXAMINER				
MULLS, JEFFREY C				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
03/20/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/587,496

Applicant(s)

TANIGUCHI ET AL.

Examiner

Jeffrey C. Mullis

Art Unit

1796

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4, 5, 7, 8 and 10-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 5, 7, 8 and 10-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Claims 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Boiling point is dependent on pressure which is not specified in claim 5 and claim 5 is therefore unclear.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 5, 7, 8, 10- 12 and 15-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Goetz et al. (US 2003/0100675).

The reference discloses thermosetting coating composition (abstract) containing epoxy functional copolymers and methacrylic block copolymers containing (carboxyl generating) TBMA units. Note Table 2 on page 17 which uses the block copolymers of Table 1.

Claims 1, 4, 5, 7, 8 and 10-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Tsuji et al. (WO 02081561).

The above WO document corresponds to US 2004/0106732 which will be referred to since it is in English.

The reference discloses a composition containing block copolymers with at least one acrylic and one methacrylic block (abstract). Note that curing agents reactive with the block copolymer may be added at paragraph 277 and that the block copolymer may

have epoxy functionality and note paragraph 371 for block copolymers with carboxyl or anhydride functionality. Fillers and lubricants may be added in paragraph 282.

Claims 1, 5, 7, 8 and 10-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Kakeda et al. WO02092696 (corresponding to US 2004/0147674).

The US reference discloses a block copolymer with a methacrylic bloc and an acrylic block (Abstract) containing a reactive functional groups and multifunctional curing agents therefor (paragraphs 277-279)..Note use of fillers and lubricants at paragraphs 281 and 282.

Claims 1, 4, 5, 7, 8 and 10-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Kaneda, cited by applicants (JP 200260449).

Note that applicants international search report (apparently submitted as applicants concise explanation required by MPEP 609 for foreign language references) indicates the reference is in the "X" category. Note that the Patent Abstracts of Japan Abstract discloses that the patent discloses compositions containing block copolymers with acrylic and methacrylic blocks with curable reactive groups.

Applicant's arguments filed 1-7-09 have been fully considered but they are not persuasive. It is not clear what the term "normal pressure" encompasses and therefore the rejection under 35 USC 112, second paragraph has been maintained.

Applicants argue that the GMA functional acrylic resin of Goetz is not reacted with the block copolymer but is reacted with the carboxylic acid group of Goetz. However, firstly it is not clear what purpose it would serve to react the acrylic of Goetz with DDDA. Furthermore acid is known to catalyze the ring opening addition reaction of

epoxides and protic materials and it therefore reasonably appears that the acrylic resin inherently reacts with the block copolymer of Goetz.

With regard to Tsuji and Kakeda applicants argue limitations not present in the claims which are given no weight such as reaction upon molding but in any case any heating such as in a thermal molding process (such as is taught by Tsuji and Kakeda) would reasonably appear to inherently result in reaction of patentees' reactive materials. Note paragraphs 12 and 13 of Kaneda for molecular weights of 30,000-500,000.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Jeffrey C. Mullis at telephone number 571 272 1075.

Jeffrey C. Mullis
Primary Examiner
Art Unit 1796

JCM

3-17-08

/Jeffrey C. Mullis/

Primary Examiner, Art Unit 1796